



PATENT

Att. Docket No. 27600/M195A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application of: Mark Dreyer et al.

Serial No: 09/388,191

Filed: September 1, 1999

For: System and Method for Automated
Closed-Loop Production of Customized
Books


Group Art Unit: 2178

Examiner: Cesar B. Paula

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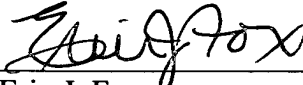
Submitted herewith is a copy of Appellant Appeal Brief with respect to the Appeal taken to the
Board of Patent Appeals and Interferences in the above-identified application.

Also enclosed is our check in the amount of \$500.00, which includes the fee for filing the
Appeal Brief. The Commissioner is hereby authorized to charge any fees that may be required under 37
CFR 1.17(f) or any deficiency therein to Deposit Account No. 50-1903. A copy of this transmittal is
attached. Any overpayment in fees should be refunded to McCracken & Frank LLP at the address
below.

Respectfully submitted,

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September 15, 2006

By: 
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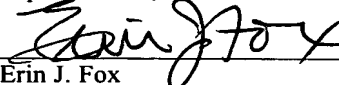
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APPEAL BRIEF

Mail Stop Appeal Brief-Patent
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Sir:

This appeal is from the Final Rejection dated April 18, 2006.

(1) Real party in interest

This appeal is made on behalf of R.R. Donnelley, located at 111 S. Wacker Drive,
Chicago, Illinois 60606.

(2) Related appeals and interferences

At present, there are no other appeals or interferences known to appellant, the
appellant's legal representative, or assignee which will directly affect or be directly affected
by or have a bearing on the Board's decision on the pending appeal.

(3) Status of claims

Claims 1-26 stand rejected and are presently being appealed.

(4) Status of amendments

No amendments have been filed subsequent to the final rejection.

(5) Summary of claimed subject matter

Claim 1, and claims 2-15 dependent directly or indirectly thereon, recite a software system for generating a second page description file from a first page description file, wherein the system includes a computer-readable medium and a routine stored on the computer-readable medium and having a first routine for generating a template. (p. 34, lines 15-20; p. 39, line 14-17). The system further includes a second routine for extraction of data from the first page description file to generate a database for storing the extracted data. (p. 35, lines 12-26). Still further, the system includes a third routine for generating a second page description file from the template and the database. (p. 34, lines 4-9; p. 38, lines 15-20). The first page description file includes at least layout information for at least one page. (p. 34, lines 4-7).

Claim 16, and claims 17-26 dependent directly or indirectly thereon, recite a method of generating a second page description file from a first page description file, wherein the method includes the step of generating a template. (p. 34, lines 15-20; p. 39, lines 14-17). The method further includes the step of extracting data from the first page description file in an automated fashion to generate a database for storing the extracted data. (p. 35, lines 12-26). Still further, the method includes the step of generating a second page description file from the template and the database. (p. 34, lines 4-9; p. 38, lines 15-20). The first page description file includes content and layout information for at least one page. (pg. 34, lines 4-7).

(6) Grounds of rejection to be reviewed on appeal

- a) Claims 1-9, 11-22, and 24-26 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Simpson, A., Sybex, 1993, pp. 539-579, 852-859 (hereinafter

“Simpson”) in view of Hohensee et al. U.S. Patent No. 6,407,821 (hereinafter “Hohensee”).

- b) Claims 10 and 23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Simpson in view of Hohensee, Cohen et al. U.S. Patent No. 5,872,640 (hereinafter “Cohen”), and Mastie U.S. Patent No. 6,480,866 (hereinafter “Mastie”).

(7) Argument

Applicants traverse the examiner’s rejection of the claims at issue as obvious over one or more of Simpson, Hohensee, Cohen, and Mastie.

- a) The rejection of claims 1-9, 11-22, and 24-26 as obvious over Simpson in view of Hohensee.

Neither of the cited references discloses or suggests, either singly or in combination, a software system for or method of generating a second page description file from a first page description file including a routine for or the steps of extracting data from a first page description file to generate a database, wherein the first page description file includes at least layout information, or both content and layout information, as specified by claims 1-9, 11-22, and 24-26.

In fact, Simpson discloses using Wordperfect® for converting an ASCII comma-delimited text file representing a database into a Wordperfect® formatted secondary merge file, which also represents the database and has field names and records to be used by Wordperfect®. A primary merge file is created in Wordperfect®, wherein the primary merge file includes static information and field names. When a merge is performed, variable data from the secondary merge file is inserted into the field names of the primary merge file for each record, thus creating a customized document for each record. The secondary merge file described in Simpson is not a page description file, because it does not comprise content and layout information for one or more pages to be printed, displayed, or otherwise reproduced.

Hohensee discloses the conversion of files from Portable Document Format (PDF) to Mixed Object Document Content Architecture (MO:DCA®) format. The two file formats generate identical output pages, but the conversion of PDF to MO:DCA® is intended to reduce redundant information that is sent to a printer and to minimize recovery time due to

print errors. In order to generate the identical output pages, the data contained in the PDF file are stored in a database and reassembled into the corresponding MO:DCA® file.

Applicants contend that it is not appropriate to combine Simpson and Hohensee to reject the claims at issue. A person of ordinary skill in the art would not have looked to the teachings of Hohensee to modify Simpson because Simpson relates to a system of merging a template with a database to create documents containing variable information that is different from page to page, and Hohensee relates to a file format conversion system for generating identical output pages. In addition, the merge feature of Simpson generates a variable page from a template and a database and is only responsive to a database that is entered by a user in comma-delimited text file format. Accordingly, the merge feature of Simpson is not responsive to files containing layout information; in particular, the secondary merge file of Simpson could not be generated from a file in PDF format. Therefore, any attempt to combine the features of Simpson and Hohensee would result in a system that would be inoperative, and hence, for this reason, it would not have been obvious to combine Simpson and Hohensee in order to arrive at the subject matter recited by the claims at issue.

Because neither of the cited references disclose or suggest that it would be desirable or even possible to provide a software system for or method of generating a second page description file from a first page description file including a routine for or step of extracting data from a first page description file to generate a database, wherein the first page description file includes at least layout information or both content and layout information, as specified by the claims under rejection, it is evident that the claims are not obvious thereover. The prior art must disclose at least a suggestion of an incentive for the claimed combination of elements in order for a *prima facie* case of obviousness to be established. See *In re Sernaker*, 217 U.S.P.Q. 1 (Fed. Cir. 1983) and *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). “Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant’s disclosure.” *In re Dow Chemical Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988).

b) The rejection of claims 10 and 23 as obvious over Simpson in view of Hohensee, Cohen, and Mastie.

Claim 10 is dependent on claim 1 and claim 23 is dependent on claim 16. As noted above in section 7a, claims 1 and 16 are not taught by Simpson. Hohensee, Cohen, and Mastie do not cure the deficiencies of Simpson because Hohensee, Cohen, and Mastie do not disclose or suggest, either singly or in combination with one another and/or in combination with Simpson, a software system for or method of generating a second page description file from a first page description file including a routine for or step of extracting data from a first page description file to generate a database, wherein the first page description file includes at least layout information or both content and layout information. Accordingly, claims 10 and 23 are not obvious over Simpson, Hohensee, Cohen, and Mastie.

Simpson and Hohensee are discussed above in section 7a, the detail of which is incorporated herein by reference.

Cohen discloses a document generation and delivery system that stores a number of pre-defined overlays, wherein each overlay includes a plurality of data fields. A set of instructions is generated to define the location of each data field within the overlay. Input data received in the form of character strings identify the overlay to be used and provide specific data for insertion into the defined data fields within the selected overlay in accordance with the associated set of instructions.

Mastie discloses a method and apparatus for assembling a set of input page files in the correct sequence to generate a single output file in the form of a digital book.

Neither Mastie, nor Cohen supply the deficiencies of Simpson and Hohensee. In fact, neither Mastie, nor Cohen disclose or suggest that it would be desirable or even possible to provide a software system for or method of generating a second page description file from a first page description file including a routine for or step of extracting data from a first page description file to generate a database, wherein the first page description file includes at least layout information or both content and layout information.

c) Summary


None of the cited references disclose or suggest, either singly or in combination, a software system for or method of generating a second page description file from a first page

description file including a routine for or the steps of extracting data from a first page description file to generate a database, wherein the first page description file includes at least layout information, or both content and layout information, as specified by the claims at issue.

Withdrawal of the final rejections dated April 18, 2006, and allowance of all claims at issue is respectfully requested.

Respectfully submitted,

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September 15, 2006

(8) Claims appendix

1. A software system for generating, from a first page description file having portions wherein each portion includes content, a second page description file, comprising:
a computer-readable medium; and
a routine stored in the computer-readable medium and including
a first routine that provides for generation of a template,
a second routine that provides for extraction of data from the first page description file to generate a database for storing the data indicative of the portions of the first page description file; and
a third routine that generates the second page description file from the template and the database;
wherein the first page description file includes at least layout information for at least one page.
2. The software system of claim 1, wherein the first routine provides a user interface for establishing placeholders in the template.
3. The software system of claim 2, wherein the user interface comprises a page make-up software application and a placeholder definition routine for establishing the placeholders in the template.
4. The software system of claim 3, wherein the page make-up software application comprises QuarkXPress®.
5. The software system of claim 1, wherein the first routine generates the template in accordance with the portions of the first page description file.

6. The software system of claim 1, wherein:
the database comprises a plurality of fields; and
the second routine provides a user interface for characterizing each portion of the portions of the first page description file as an instance of at least one of the fields of the plurality of fields of the database.

7. The software system of claim 1, wherein:
each portion of the first page description file comprises a first data portion and a second data portion; and
the second routine provides a user interface for parsing each portion of the first page description file to separate the first data portion from the second data portion.

8. The software system of claim 7, wherein the first data portion of each portion comprises content data and the second data portion of each portion comprises control data.

9. The software system of claim 8, wherein the user interface of the second routine stores the first data portion of each portion in the database.

10. The software system of claim 1, wherein the template is associated with a plurality of pages to be printed in a book.

11. The software system of claim 1, wherein:
the database comprises a plurality of records;
the template is one of a plurality of templates; and
each record of the database comprises information indicative of a certain template of the plurality of templates.

12. The software system of claim 1, wherein:
the portions of the first page description file comprise an image element; and
the second routine further generates an image file for storing image data indicative of the image element.

13. The software system of claim 12, wherein the third routine generates the second page description file from the image file.

14. The software system of claim 1, wherein the routine comprises a fourth routine that provides for modifying the data stored in the database prior to generation of the second page description file.

15. The software system of claim 14, wherein the fourth routine provides a user interface for modifying the data stored in the database.

16. A method of generating, from a first page description file having portions wherein each portion includes content, a second page description file, the method comprising the steps of:

generating a template;

extracting data from the first page description file in an automated fashion to generate a database that stores the data indicative of the portions of the first page description file; and

generating the second page description file from the template and the database;

wherein the first page description file includes content and layout information for at least one page.

17. The method of claim 16, wherein the template generating step comprises the step of establishing placeholders in a file developed in a page make-up software application.

18. The method of claim 16, wherein the template generating step generates the template in accordance with the portions of the first page description file.

19. The method of claim 16, wherein:
the database comprises a plurality of fields; and
the data extracting step comprises the step of characterizing each portion of the first page description file as an instance of at least one of the fields of the plurality of fields of the database.

20. The method of claim 16, wherein:
each portion of the first page description file comprises a first data portion and a second data portion; and
the data extracting step comprises the step of parsing each portion of the first page description file to separate the first data portion from the second data portion.

21. The method of claim 20, wherein the first data portion of each portion comprises content data and the second data portion of each portion comprises control data.

22. The method of claim 21, wherein the data extracting step comprises the step of storing the first data portion of each portion in the database.

23. The method of claim 16, wherein the template is associated with a plurality of pages to be printed in a book.

24. The method of claim 16, wherein:
the template is one of a plurality of templates;
the database comprises a plurality of records; and
each record in the database identifies a certain template of the plurality of templates.

25. The method of claim 16, wherein:
the portions of the first page description file comprise an image element; and
the data extracting step comprises the step of generating an image file for storing image data indicative of the image element.

26. The method of claim 16, further comprising the step of modifying the data stored in the database to reflect modified content such that the second page description file generating step comprises the step of generating the second page description file from the modified data stored in the database.

(9) Evidence appendix

None.

(10) Related proceedings appendix

None.